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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/086,116

02/26/2002

Roy Neff

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7590

08/05/2008

BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP

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CLEVELAND, OH 44114

EXAMINER

AKINTOLA, OLABODE

ART UNIT

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3691

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/086,116	<b>Applicant(s)</b> NEFF ET AL.	
	<b>Examiner</b> OLABODE AKINTOLA	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 136-141 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 136-141 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26 and 136-141 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1, 7, 13-15, 20, 25, 26 recite the limitation “the at least one condition allowing matching without revealing a security symbol in the order to the market maker”. This limitation is not supported or disclosed in the original disclosure and therefore constitute new matter. Applicant is requested to cite relevant portion(s) of the disclosure that teaches this limitation. Examiner notes that paragraphs 0309-0310 of USAP 20030014351 recite

“[0309] Marketmakers are able to set up price/size tiers for automatic responses and are further able to set up Marketmaker Toolkit Monitors (Trade Tickers, and Position and P&L Reports) as they do for two-sided orders. Responses can be placed automatically, that is without directly viewing the incoming order, or manually.

[0310] In another example, should a marketmaker be using the tool kit for a barter basket order, the marketmaker may have the tool kit describe a basket order in terms of industry

composition and certain risk characteristics *with or without revealing industry symbols and/or individual symbol amounts.*” (Emphasis added)

However, Examiner notes that the recitation does not correlate with the claim limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 and 136-141 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claims 1, 7, 13-15, 20, 25, 26 recite the limitation “the at least one condition allowing matching without revealing a security symbol in the order to the market maker”. The purpose of this limitation is not clear. When a marketmaker generates a rule for automatically responding to an order, the rule including at least a condition for automatically generating a contra order, it is certainly inherent that the if the condition or rule involves matching, the security symbol in the order would not be revealed to the marketmaker , since the marketmaker has already set up automatic response including that involving the matching. Having the symbol or any activity carried out in the automatic response revealed to the marketmaker defeats the purpose for the automatic response.

The claim limitation is interpreted in light of the 35 U.S.C. 112, second paragraph above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26, 136 and 138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer et al (USPN 6418419) in view of Ojha et al (USPN 6598026).

Re claims 1, 7, 13 and 14: Nieboer discloses a method operable on a computer for responding to order flow, the method comprising: receiving from a trader an order; matching on the computer the order to the at least one condition comprising a rule (col. 2, lines 12-18; col. 3, lines 60-67); and automatically responding to the order in accordance with the at least one condition of the rule, if the at least one condition is satisfied, including generating a contra barter order that includes the contra order (col. 2, lines 12-18; col. 19, lines 1-20; see abstract).

Nieboer does not explicitly teach generating for a market maker a rule for automatically responding to an order, the rule including at least one condition for automatically generating a contra order, the at least one condition allowing matching without revealing a symbol in the order to the market maker; providing the contra order for acceptance.

Nieboer however disclosed that orders are sent and received from the Nasdaq market makers.

Nieboer further discloses means for matching orders including if the condition are met, that two or more securities are tradable.

Ojha discloses the concept of generating for a market maker a rule for automatically responding

to an order, the rule including at least one condition for automatically generating a contra order, the at least one condition allowing matching without revealing a symbol in the order to the market maker; providing the contra order for acceptance (see col. 7, lines 46-58, col. 15, lines 30 through col. 17, line 15; Figs. 13A-13K). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nieboer to include these features as taught by Ojha in order to automatically generate appropriate contra order according the rules defined by the market participant.

Re claims 2, 8 and 16: Nieboer discloses the order further includes an effective time range (col. 2, lines 1-5; col. 15, lines 50-65; col. 8, lines 29-54; col. 17, lines 25-67).

Re claims 3, 9, 18 and 23: Nieboer discloses wherein: the order includes first and second securities; and the at least one condition includes at least one variable selected from the group of variables including: identity of one of the first and second securities, delta between buy and sell prices of the first and second securities, relationship of SIC codes of at least one of the first and second securities and any other securities, market cap of at least one of the first and second securities, average daily trading volume of at least one of the first and second securities and debit value of the bid/ask spread of the first and second securities (col. 1, lines 42-65; col. 9, line 1 – col. 10, line 12).

Re claims 4 and 10: Nieboer discloses wherein each of the conditions further includes a mathematical operator and a value (col. 15, lines 1-10).

Re claims 5 and 11: Nieboer discloses wherein the rule further includes at least one pricing tier comprising an offer price range within which the rule is operative and an offer size value up to which the rule is operative (col. 8, lines 27-54); and if the rule is operative and if the at least one condition of the rule is satisfied, providing the contra order for the acceptance includes: if the order is a limit order, performing one of trading the order with at least one of a second order and contra order, (see fig. 8; col. 10, line 11-65), and posting the order request for consideration for execution; if the order is a market order, trading the order with at least one of the second order and the contra order; and if the contra order is accepted, trading the order (see fig. 8; col. 10, lines 11-65).

Re claims 6 and 12: Nieboer discloses wherein the step of automatically responding includes prompting the operator to provide a manual response (col. 13, lines 1-40).

Re claims 15, 20, 25 and 26: see claims 1, 7, 13 and 14 analyses above.

Re claims 17 and 22: Nieboer discloses wherein receiving includes selecting at least one variable from the plurality of variables and operators, at least one operator from the plurality of variables and operators, and at least one constraint to form the at least one condition (see col. 17, table 1; col. 15, lines 1-45).

Re claims 19 and 24: Nieboer discloses wherein the rule further includes at least one pricing tier

comprising an offer price range within which a rule is operative and an offer size value up to which a rule is operative (col. 11, lines 40-60).

Re claim 21: Nieboer discloses wherein: the order further includes a time and date range (col. 2, lines 1-5; col. 15, lines 50-65; col. 8, lines 29-54; col. 17, lines 25-67).

Re claims 136 and 138: Nieboer further discloses the method wherein the contra order includes a first security and a second security (col. 8, lines 29-54; col. 17, lines 25-67; col. 19, lines 1-20)

Claims 137 and 139-141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer in view of Ojha as applied to claims 1 or 13, and 7 or 14 above, and further in view of Nordlicht et al (USPAP 20050137964).

Re claims 137, 139, 140 and 141: Nieboer failed to explicitly disclose the method wherein the contra order is an implied order.

Nordlicht et al discloses the method wherein the contra order is an implied order (section 0158). Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Nieboer and incorporate the method wherein the contra order is an implied as taught by Nordlicht et al in order to respond to users' exact orders by generating implied order.



***Response to Arguments***

Applicant's arguments filed 6/02/2008 have been fully considered but they are not persuasive.

Applicant's argument regarding the limitation has been addressed in the U.S.C. 112 rejection above.

Regarding applicability of the Nordlicht reference, Examiner respectfully disagrees with Applicant's assertion. Examiner notes that none of the cited continuity applications (i.e. 60/271,541; 09/454035, 60/161,318 and 60/147,243) has support for the implied order. Therefore, the limitation has not been given priority to any of the cited applications. Applicant is requested to cite relevant portion(s) of these disclosures that teaches this limitation.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/  
Primary Examiner, Art Unit 3691